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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,924	02/28/2002	John J. Koresko V	10717-1U1	1681

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,924

Applicant(s)

KORESKO, JOHN J.

Examiner

Stefano Karmis

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on 26 January 2004.

Status of Claims

2. Claims 1-5 and 12 have been amended in the same amendment. Claims 6-11 and 13-36 have been left as originally filed. Therefore claims 1-36 are under prosecution in this application.

Summary of this Office Action

3. Applicant's arguments filed on 26 January 2004 have been fully considered. The rejection in the previous office action is therefore withdrawn. Claims 1-36 have been rejected under new prior art. Any previous arguments are now moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 12, 19-23 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, “electronically generating a separate agreement that extra-contractually modifies the variable life insurance policy, wherein the plan includes the policy and the separate agreement. There is no language in the claim that allows the Examiner to interpret the basis for electronically generating a separate agreement to extra-contractually modify the variable life insurance policy. In steps (a) and (b) of claim 1, Applicant clearly describes entering, via at least one user interface, actuarial data and based on that actuarial data creating a defined benefit pension plan and generating a variable life insurance policy to fund the defined benefit pension plan. The limitation described in step (c) is unclear in its meaning and therefore the Examiner interprets it to include the ability to modify the variable life insurance policy to obtain a desired result. Claims 2-5, 12, 19-23 and 30 possess a similar limitation and are interpreted the same as claim 1 mentioned above.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, 11-16, 18-27, 29-34 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al. (hereinafter Ryan) U.S. Patent 6,304,859.

Regarding claims 1-5, and 12, Parsons discloses a computer-implemented data-processing method for creating a defined benefit pension plan funded using variable life insurance contracts or annuity contracts, by entering, via at least one user interface, actuarial data used to create the defined benefit pension plan, based on the actuarial data, electronically generating a variable life insurance policy used to fund the defined benefit pension plan (column 1, lines 8-15 and column 8, line 59-column 9-17); electronically generating a separate agreement the extra-contractually modifies the variable life insurance policy and defines the terms of the agreement (column 9, lines 18-65).

Claims 6-7 and 13-14, determining a negotiated guaranteed rate or return for the defined benefit pension plan (column 9, lines 18-55). Determining after a predetermined period of time,

whether earnings based on funds contributed to the defined benefit pension plan exceed the guaranteed rate of return, and if so, setting an “actual earnings” parameter to determine future contributions to the defined pension plan (column 11, line 1 thru column 12, line 17 and Fig. 4).

Claims 8 and 15, the life insurance policy is a variable life insurance policy and the annuity policy is a variable annuity policy (column 3, lines 23-31).

Claims 9 and 16, electronically generating a software illustration associated with the selected policy based on information received from at least one remotely located processor that processed the actuarial data (column 12, line 65 thru column 13, line 12).

Claims 11 and 18, allocating funds contributed to the defined benefit pension plan between a General Account and a Variable Account (column 3, lines 23-31).

Regarding independent claims 19-23, and 30, Parsons discloses a computer-implemented data-processing system for creating a defined benefit pension plan funded using variable life insurance contracts or annuity contracts, by entering, via at least one user interface, actuarial data used to create the defined benefit pension plan, based on the actuarial data, electronically generating a variable life insurance policy used to fund the defined benefit pension plan (column 1, lines 8-15 and column 8, line 59-column 9-17); electronically generating a separate agreement the extra-contractually modifies the variable life insurance policy and defines the terms of the agreement (column 9, lines 18-65).

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Claims 24-25 and 31-32, determining a negotiated guaranteed rate or return for the defined benefit pension plan (column 9, lines 18-55). Determining after a predetermined period of time, whether earnings based on funds contributed to the defined benefit pension plan exceed the guaranteed rate of return, and if so, setting an "actual earnings" parameter to determine future contributions to the defined pension plan (column 11, line 1 thru column 12, line 17 and Fig. 4).

Claims 26 and 33, the life insurance policy is a variable life insurance policy and the annuity policy is a variable annuity policy (column 3, lines 23-31).

Claims 27 and 34, electronically generating a software illustration associated with the selected policy based on information received from at least one remotely located processor that processed the actuarial data (column 12, line 65 thru column 13, line 12).

Claims 29 and 36, allocating funds contributed to the defined benefit pension plan between a General Account and a Variable Account (column 3, lines 23-31).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10, 17, 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (hereinafter Ryan) U.S. Patent 6,304,859.

Claims 10, 17, 28 and 35, Ryan teaches a defined benefit pension plan funded by variable life insurance contracts (column 1, lines 8-15). Ryan fails to specify that the benefit pension plan is a variable 412(i) defined benefit pension plan. Official Notice is taken that a 412(i) defined

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benefit pension plans is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Ryan to specify 412(i) benefit pension plans because it is a common and familiar type of benefit plan funded by life insurance contracts and the guaranteed cash values needed in a 412(i) defined benefit pension plan do not alter the teachings of Ryan.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Barnowski et al., US Patent 5,926,800 Jul. 20, 1999. System and method for providing a line of credit secured by an assignment of a life insurance policy.
- b) DiCresce, US Patent 5,991,744 Nov. 23, 1999. Method and apparatus that processes financial data relating to wealth accumulation plans.
- c) Bell, US Patent 6,161,096 Dec. 12, 2000. Method and apparatus for modeling and executing deferred award instrument plan.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
25 February 2004



HANI M. KAZIMI
PRIMARY EXAMINER